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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* DEAN A. SEIFERT, EARNEY E. STOUTENBURG,
9 DAVID A. OWEN, and MAURA A. FITZGERALD
10

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12 Appeal 2007-4119
13 Application 09/975,171
14 Technology Center 3600
15

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17 Decided: August 8, 2008
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20 Before LINDA E. HORNER, ANTON W. FETTING, and
21 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
22 FETTING, *Administrative Patent Judge*.

23 DECISION ON APPEAL

24 STATEMENT OF CASE

25 Dean A. Seifert, Earney E. Stoutenburg, David A. Owen, and Maura A.
26 Fitzgerald (Appellants) seek review under 35 U.S.C. § 134 of a Final
27 rejection of claims 1-65, the only claims pending in the application on
28 appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM.

The Appellants invented a way of performing a money transfer transaction that involves loading payout funds in a payout account that is electronically accessible by a recipient. As a result, an agent that may be involved in the transaction does not need to dispense significant amounts of cash to the recipient (Specification 3:13-17). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced in the Analysis section below.

This appeal arises from the Examiner's Final Rejection, mailed March 22, 2005. The Appellants filed an Appeal Brief in support of the appeal on August 7, 2006. An Examiner's Answer to the Appeal Brief was mailed on November 2, 2006. A Reply Brief was filed on January 3, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

| | | |
|---------|-----------------|---------------|
| Konya | US 5,937,396 | Aug. 10, 1999 |
| Ballard | US 6,032,137 | Feb. 29, 2000 |
| Berg | US 6,394,343 B1 | May 28, 2002 |
| Cooper | US 6,736,314 B2 | May 18, 2004 |

REJECTIONS¹

Claims 58 and 60 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

Claims 1-5, 14-21, 31-37, 45-49, and 60 stand rejected under 35 U.S.C. § 102(b) as anticipated by Konya.

Claims 6, 22, 38, and 50 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Konya and Berg.

Claims 7-13, 23-29, 39-41, and 51-53 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Konya, Berg, and Cooper.

Claims 10-13, 26-30, 42-44, 54-59, and 61-64 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Konya.

Claim 65 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Konya and Ballard.

ISSUES

The issues pertinent to this appeal are:

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 58 and 60 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

¹ The Examiner withdrew rejections against claim 65 under 35 U.S.C. § 112, first paragraph, claim 30 under 35 U.S.C. § 112, second paragraph, and

- 1 • Whether the Appellants have sustained their burden of showing that
2 the Examiner erred in rejecting claims 1-5, 14-21, 31-37, 45-49, and
3 60 under 35 U.S.C. § 102(b) as anticipated by Konya.
- 4 • Whether the Appellants have sustained their burden of showing
5 that the Examiner erred in rejecting claims 6, 22, 38, and 50 under
6 35 U.S.C. § 103(a) as unpatentable over Konya and Berg.
- 7 • Whether the Appellants have sustained their burden of showing that
8 the Examiner erred in rejecting claims 7-13, 23-29, 39-41, and 51-53
9 under 35 U.S.C. § 103(a) as unpatentable over Konya, Berg, and
10 Cooper.
- 11 • Whether the Appellants have sustained their burden of showing that
12 the Examiner erred in rejecting claims 10-13, 26-30, 42-44, 54-59,
13 and 61-64 under 35 U.S.C. § 103(a) as unpatentable over Konya.
- 14 • Whether the Appellants have sustained their burden of showing that
15 the Examiner erred in rejecting claim 65 rejected under 35 U.S.C.
16 § 103(a) as unpatentable over Konya and Ballard

17 The pertinent issues turn on whether Konya describes loading payout
18 funds in a payout account associated with a payout card.

antecedent basis rejection of claim 58 under 35 U.S.C. § 112, second
paragraph (Answer 13).

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of “account.”

02. The ordinary and customary meaning of “account” within the context of financial transactions is a formal banking, brokerage, or business relationship established to provide for regular services, dealings, and other financial transactions.²

Konya

03. Konya is directed to conducting financial transactions for transferring currency for disbursement at a remotely located automated teller machine (Konya 1:6-9).

04. Konya shows how it transfers funds in its Figs. 6A and B.

05. The individual may elect to transfer currency to a second account (Konya 10:15-16).

06. The sender enters the amount to be transferred. The transaction proceeds only if the balance in the sender’s account is sufficient (Konya 10:28-41).

² *American Heritage Dictionary of the English Language* (4th ed. 2000).

- 1 07. The sender then enters the recipient's account number to which
2 the funds are to be sent. Konya's system verifies this account
3 exists (Konya 10:42-61).
- 4 08. Information regarding the transaction is transmitted to the main
5 computer. This information may contain the number of the first
6 account, the amount of currency transferred, and the routing code
7 of the first bank (Konya 10:64 – 11:2).
- 8 09. Konya's system then reserves the amount of currency requested
9 in the first account (Konya 11:6-8).
- 10 10. Konya shows how it receives transferred funds in its Figs. 7A
11 and B.
- 12 11. The funds are retrieved from an ATM with a transaction card
13 (Konya 11:15-17).
- 14 12. Konya describes how the recipient may elect to perform routine
15 banking functions or receive the currency recently transferred to
16 the second account (Konya 11:27-30).
- 17 13. When the recipient desires to withdraw the funds that have been
18 transferred, the recipient's bank's computer system transmits the
19 recipient's account number for verification (Konya 11:33-35).
- 20 14. The recipient enters the account information using the
21 transaction card, and a PIN into the ATM. Then the recipient may
22 have the ATM dispense the transferred amount. There may be
23 restrictions on the amount actually dispensed depending on the

1 bank or ATM network, so the recipient can perform subsequent
2 transactions if needed (Konya 11:41-48).

3 15. The computer controlling the dispensing sends the recipient's
4 account number and routing code, along with the sender's account
5 number and routing code back to the computer controlling the
6 sender's account, from which the amount is finally debited
7 (Konya 11:49-66).

8 16. Konya also allows linking of wire transfer systems to the
9 currency transfer system (Konya 12:26-27).

10 *Berg*

11 17. Berg is directed to electronic transfer of money using credit
12 card sized smart cards that receive and store data representing
13 monetary values and selectively transfer data to another device to
14 transfer all or a portion of the stored monetary values (Berg 1:5-
15 11).

16 18. Berg describes including the identification of the source of
17 monetary values transferred into its smart card and identification
18 of the destination of monetary values transferred out of its smart
19 card (Berg 8:41-45).

20 *Cooper*

21 19. Cooper is directed to transferring funds with a card issued to a
22 sender that enables the sender to transfer funds at independent
23 host locations. The transfer card is encoded with information

1 about the sender and the intended receiver so that transfer forms
2 are not required for each transaction (Cooper: Abstract & 2:8-23).

3 *Ballard*

4 20. Ballard is directed to an automated system to retrieve
5 transaction data at remote locations, to encrypt the data, to
6 transmit the encrypted data to a central location, to transform the
7 data to a usable form, to generate informative reports from the
8 data and to transmit the informative reports to the remote locations
9 (Ballard 1:16-21).

10 *Facts Related To The Level Of Skill In The Art*

11 21. Neither the Examiner nor the Appellants has addressed the level
12 of ordinary skill in the pertinent arts of financial transactions. We
13 will therefore consider the cited prior art as representative of the
14 level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261
15 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific
16 findings on the level of skill in the art does not give rise to
17 reversible error ‘where the prior art itself reflects an appropriate
18 level and a need for testimony is not shown’”) (quoting *Litton*
19 *Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163
20 (Fed. Cir. 1985).

21 *Facts Related To Secondary Considerations*

22 22. There is no evidence on record of secondary considerations of
23 non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily)

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

1 “[A] claim preamble has the import that the claim as a whole suggests
2 for it.” *Bell Communications Research, Inc. v. Vitalink Communications*
3 *Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995). If the claim preamble, when read
4 in the context of the entire claim, recites limitations of the claim, or, if the
5 claim preamble is “necessary to give life, meaning, and vitality” to the
6 claim, then the claim preamble should be construed as if in the balance of
7 the claim. *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951). “If, however,
8 the body of the claim fully and intrinsically sets forth the complete
9 invention, including all of its limitations, and the preamble offers no distinct
10 definition of any of the claimed invention’s limitations, but rather merely
11 states, for example, the purpose or intended use of the invention, then the
12 preamble is of no significance to claim construction because it cannot be
13 said to constitute or explain a claim limitation.” *Pitney Bowes, Inc. v.*
14 *Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999).
15 *Indefiniteness*

16 Under 35 U.S.C. § 112, ¶ 2, the claims of a patent must “particularly
17 point[] out and distinctly claim[] the subject matter which the applicant
18 regards as his invention.” “A claim is considered indefinite if it does not
19 reasonably apprise those skilled in the art of its scope.” *IPXL Holdings,*
20 *L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1383–84 (Fed. Cir. 2005).
21 “Because a claim [in an issued patent] is presumed valid, a claim is
22 indefinite only if the ‘claim is insolubly ambiguous, and no narrowing
23 construction can properly be adopted.’” *Honeywell Int’l, Inc. v. Int’l Trade*
24 *Comm’n*, 341 F.3d 1332, 1338–39 (Fed. Cir. 2003) (quoting *Exxon Research*
25 *& Eng’g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001)).

1 *Anticipation*

2 "A claim is anticipated only if each and every element as set forth in the
3 claim is found, either expressly or inherently described, in a single prior art
4 reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,
5 631 (Fed. Cir. 1987). "When a claim covers several structures or
6 compositions, either generically or as alternatives, the claim is deemed
7 anticipated if any of the structures or compositions within the scope of the
8 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
9 Cir. 2001). "The identical invention must be shown in as complete detail as
10 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d
11 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
12 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology
13 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

14 *Obviousness*

15
16 A claimed invention is unpatentable if the differences between it and
17 the prior art are "such that the subject matter as a whole would have been
18 obvious at the time the invention was made to a person having ordinary skill
19 in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 127 S.Ct.
20 1727 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

21 In *Graham*, the Court held that that the obviousness analysis is
22 bottomed on several basic factual inquiries: "[(1)] the scope and content of
23 the prior art are to be determined; [(2)] differences between the prior art and
24 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
25 in the pertinent art resolved." 383 U.S. at 17. *See also KSR Int'l v. Teleflex*
26 *Inc.*, 127 S.Ct. at 1734. "The combination of familiar elements according to

1 known methods is likely to be obvious when it does no more than yield
2 predictable results.” *KSR*, at 1739.

3 “When a work is available in one field of endeavor, design incentives
4 and other market forces can prompt variations of it, either in the same field
5 or a different one. If a person of ordinary skill can implement a predictable
6 variation, § 103 likely bars its patentability.” *Id.* at 1740.

7 “For the same reason, if a technique has been used to improve one
8 device, and a person of ordinary skill in the art would recognize that it would
9 improve similar devices in the same way, using the technique is obvious
10 unless its actual application is beyond his or her skill.” *Id.*

11 “Under the correct analysis, any need or problem known in the field
12 of endeavor at the time of invention and addressed by the patent can provide
13 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

14 *Automation of a Known Process*

15 It is generally obvious to automate a known manual procedure or
16 mechanical device. Our reviewing court stated in *Leapfrog Enterprises Inc.*
17 *v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary
18 skill in the art would have found it obvious to combine an old
19 electromechanical device with electronic circuitry “to update it using
20 modern electronic components in order to gain the commonly understood
21 benefits of such adaptation, such as decreased size, increased reliability,
22 simplified operation, and reduced cost. . . . The combination is thus the
23 adaptation of an old idea or invention . . . using newer technology that is
24 commonly available and understood in the art.” *Id.* at 1163.

ANALYSIS

Claims 58 and 60 rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

Claim 58 requires determining prior to loading whether the card is eligible to receive the transaction (from claim 57) and determining whether the payout card was previously assigned to an agent location involved in the receive transaction. The Examiner found that one of ordinary skill would not have known how to determine the identity of an agent prior to loading a card (Answer 4 & 14). The Appellants contend that the Specification demonstrates that the limitation in claim 58 simply means determining whether cards are at an agent location prior to loading (Reply Br. 2-3). We agree. Nothing in claim 58 requires determining the precise party or agent who ultimately ends up with a funded card, but only that an agent is identified. While perhaps broad, this is not indefinite.

Claim 60 requires that the payout account is not accessible by the sender. The Examiner found that one of ordinary skill would not have known how to avoid the claimed access, since the sender has to load the funds, necessitating access (Answer 4 & 14). The Appellants contend that loading is part of a receive rather than a send transaction, so the sender does not load funds into the payout account (Reply Br. 3-4). While neither claim 1 nor 60 delineates the scope or otherwise defines a receive transaction, we agree that the requirement simply means that the payout account is shielded in some fashion from the sender. One of ordinary skill would have known that the way Konya provides this, by having the bank's system create the payout

1 account and move the payout funds into it (FF 09), would be one way to
2 achieve this.

3 The Appellants have sustained their burden of showing that the
4 Examiner erred in rejecting claims 58 and 60 under 35 U.S.C. § 112, second
5 paragraph, as failing to particularly point out and distinctly claim the
6 invention.

7 *Claims 1-5, 14-21, 31-37, 45-49, and 60*
8 *rejected under 35 U.S.C. § 102(b) as anticipated by Konya.*

9 *Claims 1-5 and 16*

10 The Appellants argue claims 1-5 and 16 as a group. That is, they did not
11 present separate arguments for each claim.

12 Accordingly, we select claim 1 as representative of the group.
13 37 C.F.R. § 41.37(c)(1)(vii) (2007).

14 The Examiner found that Konya anticipated claim 1 as follows
15 [bracketed matter, including citations to where the Examiner found Konya
16 anticipated limitations (Answer 12-13), and some paragraphing added]:

- 17 1. A method for performing a money transfer receive
18 transaction, the method comprising:
19 loading payout funds, [Konya: abstract – transfer of funds]
20 [a] corresponding to at least a portion of a desired
21 amount of money to be transferred from a sender to a
22 recipient, [Konya 9:29-37; 10:27-31; 11:6-8; 11:60-65]
23 [b] in a payout account associated with a payout card,
24 [Konya 11:17-20]

[c] such that the payout funds are electronically accessible by the recipient using the payout card. [Konya 11:40-43]

The Appellants contend that Konya does not transfer funds to a second account card, but only uses the card to identify the recipient when the recipient withdraws funds. The Appellants conclude that no loading of funds into a card account occurs (Appeal Br. 11:Claim 1). The Appellants argue that even when the recipient has an account at a different institution, no transfer occurs from the sender until after funds are dispensed (Appeal Br. 12:First full ¶). The Examiner responds by finding that Konya's reserving of sender's funds are a transfer to a payout account (Answer 14-15). The Appellants then argue that Konya's reserving of funds are not part of a receive transaction, but part of a send transaction instead (Reply Br. 4:Last full ¶).

We disagree with Appellants' position. To a large extent, the Appellants' arguments go to the issue of whether Konya loads funds into a separate account. Thus, we must first construe the limitation of an account. The Specification provides no lexicographic definition, but the ordinary and customary meaning of "account" within the context of financial transactions is a formal banking, brokerage, or business relationship established to provide for regular services, dealings, and other financial transactions (FF 01 & 02). So a payout account is a formal relationship established to provide for payout services.

Since the Appellants' arguments also relate to the claim limitation of loading payout funds into a payout account, we must construe this limitation.

1 Since the claim explicitly requires electronic accessibility of the funds, the
2 loading is electronic rather than mechanical. That is, loading is not a matter
3 of physically placing physical assets within a physical container, but instead
4 is a matter of placing data in some electronic storage. This data, by the
5 terms of claim 1 must represent funds, and be associated with a payout
6 account, i.e. a formal relationship established to provide for payout services.
7 So loading payout funds in a payout account is placing data representing a
8 payout amount in a data storage representing a formal relationship
9 established to provide for payout services.

10 Konya is directed to transferring currency for disbursement to remote
11 ATMs (FF 03). Konya's sender enters the amount to be sent and the
12 recipient's account number to which the funds are to be sent, and this
13 account is verified as to existence (FF 06, 07). The recipient uses a card
14 with the recipient's account number at an ATM to receive the funds (FF 14).
15 Konya explicitly refers to transferring funds to a second account (FF 05, 12,
16 & 14). Thus, by Konya's explicit description, Konya transfers funds to a
17 payout account associated using the recipient's ATM card as a payout card.

18 Thus, in the face of this description, we take the Appellants' arguments
19 to mean that, in spite of Konya's explicit description to the contrary, Konya
20 is not actually transferring funds to a second account. We take the
21 Appellants' use of the word "actually" in the italicized phrase "*are not*
22 *actually transferred*" and the quotation marks around the word "transferred"
23 in the phrase "to withdraw the 'transferred' funds" (Appeal Br. 11:Claim 1)
24 to be evidence that this is the manner of the Appellants' argument.

1 This rejection of anticipation is based on the description of Konya
2 anticipating the rejected claims. Since the rejection is based on a
3 description, and descriptions may appear ambiguous to those with little
4 background, the description is read as it would be understood by one of
5 ordinary skill. Thus, the Appellants appear to be arguing that one of
6 ordinary skill would have understood Konya's explicit recitations to be
7 metaphoric rather than realistic, and would have instead understood Konya
8 to have not made a transfer to a payout account. In the face of an
9 unambiguous recitation that funds have been transferred, we find that the
10 burden of showing this to not be the case is particularly heavy.

11 The Appellants' describe Konya as describing retaining the payout funds
12 in the sender's account until after the funds are dispensed, and therefore,
13 since the funds have been dispensed, no loading into a payout account can
14 occur (Appeal Br. 11:Claim 1). We find this to be an overly broad
15 characterization of the steps performed by Konya, overlooking several
16 highly pertinent steps when examined in greater detail.

17 First, we find that Konya describes loading funds within the sender's
18 bank. Konya explicitly reserves the funds that are to be sent (FF 09). Such
19 a reservation isolates the reserved funds from unreserved funds, creating a
20 separate relationship, i.e. a separate account. Whether both the reserved and
21 unreserved funds both have an account number in common does not negate
22 their separation. Those of ordinary skill in the financial arts simply refer to
23 such separate accounts as sub-accounts. Although these reserved funds still
24 are related to the sender's account number, they are also related to the
25 recipient's account number (FF 07, 08, & 09). Thus, Konya's reserving

1 funds places data representing a payout amount in a data storage
2 representing a formal relationship established to provide for payout services,
3 meeting the claim limitation of loading funds as properly construed.

4 Second, we find that Konya describes loading funds when the recipient
5 enters his card into an ATM. When the recipient enters his account number
6 via the card, then this account number is verified and the cash may be
7 dispensed (FF 13 & 14). This is simply in accord with basic accounting
8 procedure required of banks; a bank must provide an audit trail of its
9 deposits and withdrawals. Thus, the amount to be dispensed is associated
10 with the recipient's card and account number within the recipient's bank, as
11 it had already been so associated with the sender's bank. Far from being
12 used solely to identify the recipient as argued by the Appellants (Appeal Br.
13 11:Claim 1), the recipient's card is used to link this withdrawal amount to
14 the recipient's bank's computer storage for the recipient's account, recording
15 cash received from an ATM, and the ATM dispensing the cash.

16 This places data representing a payout amount in a recipient bank's data
17 storage representing a formal relationship established to provide for payout
18 services, meeting the claim limitation of loading funds as properly
19 construed. Far from not transferring funds prior to dispensing cash, one of
20 ordinary skill would see that Konya describes at least two such transfers, one
21 to a reserved funds account and one to the recipient's account of cash
22 received from an ATM. Both of these accounts are associated with the
23 recipient's account on the recipient's card, acting as a payout card. And in
24 the face of Konya's explicit description of these activities as transferring
25 funds, we find that these activities are, in fact, transfers.

The Appellants appear to argue that Konya's description of not completing the transaction until after the information is returned to the sender's bank (Appeal Br. 12:First full ¶), indicates that no transfers occur until that point. This is simply inconsistent with ordinary accounting procedure. As the transaction progresses from unreserved to reserved funds and from the sender's bank to the recipient's bank and account, the information representing these transaction components are necessarily processed, for otherwise there would be no accounting possible.

One of ordinary skill in the accounting arts knew that Konya's description of the transaction being incomplete until the final debit meant only that there were further transfers to record beyond those already recorded until that point, not that no transfers had occurred.

Finally, as to the Appellants' argument that the claim is for a receive transaction, this is no more than a field of use limitation in the preamble. The body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention's limitations, but rather merely states, for example, the purpose or intended use of the invention. Thus, the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999).

Claims 17-21

The Appellants argue claims 17-21 as a group. Accordingly, we select claim 17 as representative of the group.

1 Claim 17 is similar to claim 1, but contains a step in the body of the
2 claim of loading payout funds if the transaction identifying information
3 matches the transaction data stored on the host computer system. The
4 Appellants relied solely on their arguments with respect to claim 1 in their
5 Appeal Brief 12-13, but argued that this limitation requires that the loading
6 occur after the matching occurs in their Reply Brief 4-5. As to the
7 arguments in support of claim 1, we make the same findings and conclusion
8 here as we did, *supra*. As to the timing of the matching relative to the
9 loading, we again find, as we did *supra*, that at least one of the loading of a
10 payout account occurs just prior to the dispensing of cash, after the recipient
11 was required to enter the card and have the data verified, i.e. matched. The
12 subsequent unloading as a result of the dispensing of cash does not negate
13 this step.

14 *Claims 14 and 15*

15 Claims 14 and 15 require authorizing issuance of a negotiable instrument
16 or cash. The Examiner lumped cash with negotiable instruments and found
17 that Konya described issuance of cash (Answer 6). The Appellants argue
18 that Konya does not describe this (Appeal Br. 13-14).

19 We disagree. Konya explicitly describes parceling out disbursements in
20 multiple withdrawals, particularly where the recipient's ATM has a limit on
21 the amount withdrawn (FF 14). Apparently the Examiner believed that cash
22 was a form of negotiable instrument. This is not strictly the case, because a
23 negotiable instrument represents money payable, whereas cash is money.
24 But since claim 14 only requires authorizing issuance of a negotiable
25 instrument, without limiting how such authorization occurs, Konya's

1 dispensing of cash certainly authorizes issuance of a negotiable instrument
2 up to the value of the cash dispensed. We find that possession of cash itself
3 is sufficient authority for anyone to purchase a traveler check or money
4 order, or even a cashier check for the amount of cash less any service fee.

5 *Claim 60*

6 Claim 60 depends from claim 1, and contains a limitation that the payout
7 account is not accessible to by sender. The Examiner found that once
8 Konya's funds were reserved, they were no long accessible by the sender
9 (Answer 17-18). The Appellants argue that the reserved funds are still in the
10 sender's account (Appeal Br. 15).

11 We disagree with the Appellants' position. The claim does not limit the
12 context in which the payout account is not accessible, so the issue is
13 whether, in some context as described in Konya, the payout account is not
14 accessible to the sender.

15 As we found *supra*, the reserved portion of Konya's funds are in an
16 account separate from the unreserved funds. Because they are reserved, the
17 sender is unable to access the contents of that account, and therefore within
18 that context, the account is not accessible by the sender.

19 Also, the loading into the recipient bank's account that we found to also
20 be in Konya, *supra*, would be into an account not accessible by the sender.

21 *Claims 31-37 and 45-49*

22 The Appellants repeat their arguments (Appeal Br. 15-22) regarding the
23 patentability of claims 1, 15, and 16 for claims 31-37 and 45-49, which are
24 system claims analogous in scope to the methods of claims 1-5, 14-16 and

1 17-21. We find the Appellants have not sustained their burden of showing
2 the Examiner erred for the same reasons we found *supra*.

3 From the above claims groupings we conclude that the Appellants have
4 not sustained their burden of showing that the Examiner erred in rejecting
5 claims 1-5, 14-21, 31-37, 45-49, and 60 under 35 U.S.C. § 102(b) as
6 anticipated by Konya.

7 *Claims 6, 22, 38, and 50 rejected under 35 U.S.C. § 103(a)*
8 *as unpatentable over Konya and Berg.*

9 Claims 6, 22, 38, and 50 require writing an account code from a system
10 to a terminal and then to a payout card. The Examiner applied Berg for this
11 limitation (Answer 7). The Appellants contend that Berg does not perform
12 this step, but only logs the sources and destinations of funds on its card
13 (Appeal Br. 23-26).

14 We disagree. We find that, as the Appellants also admit (Appeal Br.
15 24:Second ¶), Berg describes including the identification of the source of
16 monetary values transferred into its smart card and identification of the
17 destination of monetary values transferred out of its smart card (FF 18). The
18 Appellants appear to argue that Berg does not do this for the purpose of
19 using those identifications to load funds into the card. We find that Konya
20 describes the necessity of entering the recipient number into its system (FF
21 07). One of ordinary skill would have known that storing such a number
22 would alleviate the need to enter the number manually. Since Berg
23 describes storing such numbers on a smart card, one of ordinary skill would
24 have known to do so for the purpose of being able to subsequently
25 automatically enter the number for cash disbursements. But perhaps more to

the point, none of the claims require that the written number be used for data entry for loading the card. Therefore the Appellants' argument that Berg uses the number for a different purpose than data entry is moot.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 6, 22, 38, and 50 under 35 U.S.C. § 103(a) as unpatentable over Konya and Berg.

Claims 7-13, 23-29, 39-41, and 51-53 rejected under 35 U.S.C. § 103(a) as unpatentable over Konya, Berg, and Cooper.

The Appellants argue that these claims are patentable for the same reasons as their independent parent claims 1, 17, 34 and 45. We found that the Appellants failed to meet their burden of showing the Examiner erred with respect to these independent claims, *supra*, and therefore the Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 7-13, 23-29, 39-41, and 51-53 under 35 U.S.C. § 103(a) as unpatentable over Konya, Berg, and Cooper.

Claims 10-13, 26-30, 42-44, 54-59, and 61-64 rejected under 35 U.S.C. § 103(a) as unpatentable over Konya.

The Appellants repeat their arguments in support of claim 1 to argue for claim 30, and argue that claims 10-13, 26-29, 42-44, 54-57, and 61-62 are patentable for the same reasons as their independent parent claims 1, 17, 34 and 45. We found that the Appellants failed to meet their burden of showing the Examiner erred with respect to these independent claims, *supra*, and therefore the Appellants have failed to meet their burden with these claims for those same reasons.

1 Claims 58, 59, 63, and 64 require determining whether the payout card
2 was previously assigned to an agent location involved in the receive
3 transaction; the payout card is not associated with the recipient prior to the
4 receive transaction; and determining whether the payout card is eligible for
5 use in the receive transaction prior to loading. The Appellants argue these
6 limitations are not described by Konya (Appeal Br. 28-30).

7 We disagree. Konya explicitly determines whether the payout card is
8 eligible for use prior to loading into the ATM when the recipient inserts the
9 card into the ATM, by the usual security check of a card used in an ATM.
10 Also, the number associated with the card is determined to be eligible prior
11 to reserving funds (FF 07). The payout card does not become a payout card
12 until after the sender makes the association between the recipient's account
13 and the sender's account. The payout card is therefore not associated with
14 the recipient prior to that transaction which is part of the transaction required
15 to receive the funds. ATM cards are owned by the banks issuing the cards
16 who act as agents, and thus reading the card inherently determines whether
17 and which agent was involved.

18 The Appellants have not sustained their burden of showing that the
19 Examiner erred in rejecting claims 10-13, 26-30, 42-44, 54-59, and 61-64
20 under 35 U.S.C. § 103(a) as unpatentable over Konya.

21 *Claim 65 rejected under 35 U.S.C. § 103(a)*
22 *as unpatentable over Konya and Ballard.*

23 The Appellants argue that this claim is patentable for the same reasons
24 as its independent parent claim 30. We found that the Appellants failed to
25 meet their burden of showing the Examiner erred with respect to

independent claim 30, *supra*, and therefore the Appellants have not sustained their burden of showing that the Examiner erred in rejecting claim 65 under 35 U.S.C. § 103(a) as unpatentable over Konya and Ballard.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-5, 14-21, 31-37, 45-49, and 60 under 35 U.S.C. § 102(b) as anticipated by Konya and in rejecting claims 6-13, 22-30, 38-44, 50-59, and 61-65 under 35 U.S.C. § 103(a) as unpatentable over Konya alone, or in combination with Berg, Cooper, and/or Ballard, but have sustained their burden of showing that the Examiner erred in rejecting claims 58 and 60 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 58 and 60 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is not sustained.
- The rejection of claims 1-5, 14-21, 31-37, 45-49, and 60 under 35 U.S.C. § 102(b) as anticipated by Konya is sustained.
- The rejection of claims 6, 22, 38, and 50 under 35 U.S.C. § 103(a) as unpatentable over Konya and Berg is sustained.
- The rejection of claims 7-13, 23-29, 39-41, and 51-53 under 35 U.S.C. § 103(a) as unpatentable over Konya, Berg, and Cooper is sustained.

